

REMARKS

This is intended as a full and complete response to the Office Action dated May 6, 2004, having a shortened statutory period for response set to expire on August 6, 2004. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-32 are pending in the application. Claims 1-34 remain pending following entry of this response. Claims 1, 6, 8, 12, 14, 16, 22, 27, and 29 have been amended. New claims 33 and 34 have been added to more clearly recite aspects of the invention. Applicants submit that neither the amendments nor the new claims introduce new matter.

35 U.S.C. § 103

Claims 1-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nielsen* (U.S. 6,405,243). The Examiner asserts that "*Nielsen* discloses, method communicating [sic] between a first system and a second system each having associated database [sic], e-mail communication facility, and interactive interface." Further, that *Nielsen* '243 discloses a first electronic document containing information, a first e-mail code to transmit the first electronic document from the first system to the second system, the e-mail code to receive, at the first system, a second electronic document from the second system and updating data in a first database based thereon.

Additionally, the Examiner concedes that *Nielsen* '243 does not explicitly disclose invoking email code, but that *Nielsen* '243 does disclose an e-mail program running on each computer in the system. Based on this, the Examiner concludes:

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made [sic] to include invoking the e-mail code in the system of the Nielson [sic]. Because the email system executes the program code to generate, send and modify, etc., program command for email system operation. Thus, email system needs invoking program code to execute the email system.

Applicants respectfully traverse the rejection. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or

suggested by the prior art. M.P.E.P. § 2143.03 (*citing In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). Applicants submit that *Nielsen* fails to teach, show, or suggest the limitations recited in claims 1-32, as amended. Accordingly, because *prima facie* obviousness of the claimed invention has not been established the claims are believed to be allowable.

Applicants claim systems and methods for updating information in multiple databases, residing on independent computer systems, wherein the computer systems do not have a direct mechanism to access a database on another system. For example, in one embodiment, Applicants claim a method of exchanging specifically encoded email messages between a computer system running a concurrent versioning system program being used to develop a software application, and a test-bed system used to test and verify the functionality of the software being developed. Both systems use a private database to store information related to their respective functions. Applicants claim a method for exchanging email messages that contain specifically encoded status information concerning the identification, source, status and resolution of "bugs" (i.e., error, flaw, mistake or fault in a computer program which prevents it from working correctly) and provide the necessary information to allow the databases on both servers to remain accurate and up-to-date. Applicants have amended claim 1 and 22 to more clearly recite this aspect of their invention.

In contrast, *Nielsen* '243 is related to an improved method and system for updating email addresses. (*Nielsen* '243 col. 1, lines 6-7). Although both *Nielsen*'243 and Applicants' inventions employ email techniques to exchange messages, simply modifying *Nielsen* to use email code, as described by applicants, fails to teach show or suggest the invention claimed by Applicants. The proposed modification simply replaces the term "email code" with "email program." The proposed modification does not change the structure, method steps, or functioning of *Nielsen* '243; rather, it merely changes a label. Furthermore, even with the modification proposed by the Examiner, the system disclosed by *Nielsen* '243 includes only a single database. (*Nielsen* '243 Fig. 1 #135). The single database stores email addresses for individual that are updated in response to an email message sent to a server in communication with the single database.

Additionally, Applicants claim a method for automatically carrying out these message exchanges in response to predetermined events. The methods for updating an email address disclosed by *Nielsen* '243, on the other hand, require a user to manually submit an updated email address to an address server. (*Nielsen* '243 col. 3 lines 52-65.) Each of the methods described and claimed by *Nielsen* '243 recite either receiving, at an address-change server, an e-mail address update message from a recipient or depend on already having received such message stored in the address-change server database (*Nielsen* '243, Fig. 1 #135.) In either case, *Nielsen* '243, as modified fails to teach, show, or suggest methods and systems for updating information in multiple databases, residing on independent computer systems, wherein the computer systems do not have a direct mechanism to access a database on another system

Furthermore, even if the modification suggested by the Examiner was operable, the Examiner fails to provide an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification as is required for a proper obviousness rejection. See M.P.E.P. 706.02(j) (D). It is unclear that methods of updating email addresses would be relevant to the fields of database access and system development or why one of ordinary skill in the art would turn to methods of updating email addresses to supply commands and data to a database that is unavailable for a direct connection.

Additionally, M.P.E.P. §2143.01 expressly states that the fact that a claimed invention might be within the capability of one of ordinary skill in the art is not sufficient to establish obviousness. See, *Ex Parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) and *In re Kotzab*, 55 USPQ2d 1313, (Fed. Cir 2000). Applicant submits that a conclusory assertion that one of ordinary skill in the art could have envisioned the claimed invention based on *Nielsen* '243 constitutes no more than impermissible hindsight reconstruction of Applicant's invention. See, *In Re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). The rejection, therefore, is improper for failing to state a basis of motivation for the combination, and applicants respectfully suggest that claims 1-32 are patentable over *Nielsen* '243 and request that the rejection be reconsidered.

PATENT

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The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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